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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/709,059	04/09/2004	Cathy A. LaPointe	CL01	3058
27797	7590	11/01/2005	EXAMINER	
RICHARD D. FUERLE 1711 W. RIVER RD. GRAND ISLAND, NY 14072			WALCZAK, DAVID J	
			ART UNIT	PAPER NUMBER
			3751	

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/709,059

Applicant(s)

LAPOINTE, CATHY A.

Examiner

David J. Walczak

Art Unit

3751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

The disclosure is objected to because of the following informalities: On line 4 of paragraph 0012 and line 3 of paragraph 0013, "lid 6" should be --lid 8--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

Claims 13-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In regard to claims 13 and 15, the specification has not enabled an embodiment wherein the diameter of the sponge is greater than the diameter of the inside of the lid. It appears that claims should define the sponge as having a diameter greater than the diameter of the rim, as opposed to the lid (see claim 4 and paragraph 0009) and the claims will be examined as such.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 3751

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Wainer.

Wainer discloses a paint touchup jar (see column 8, lines 48-52) comprised of a cylindrical container 17 having a base, vertical sides and a threaded rim 19, 35, a threaded lid 89 that can be screwed onto the rim and a cylindrical sponge 97 (see column 7, lines 49-51) attached to the inside of the threaded rim.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 4-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wainer. In regard to claim 2, the container 17 is made from plastic (see column 4, lines 34-40) although the Wainer reference does not disclose that the lid is made from plastic and that the container and lid are made from transparent plastic, the Examiner takes official notice that such paint containers and lids are commonly made from transparent plastic in order to enable a user to view the contents of the container. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to form the lid and container of the Wainer device from a

transparent plastic in order to enable a user to view the contents of the container. In regard to claim 4, the diameter of the sponge 97 exceeds the diameter of the rim (the lower portion of element 19), particularly when element 19 is compressed as in Figure 7. Although the Wainer reference does not disclose the dimensions of the sponge or rim, the Examiner takes official notice that it would have been obvious to one of ordinary skill in the art at the time the invention was made that the sponge and rim can be designed to have any suitable dimensions, including the claimed dimensions, without effecting the overall operation of the device. In regard to claims 5 and 6, Although the Wainer reference does not disclose the specific type of paint used therein, the Examiner takes official notice that it would have been obvious to one of ordinary skill in the art at the time the invention was made that any suitable paint, including the claimed paint, can be used in the Wainer device (depending on the needs of the user), without effecting the overall operation of the device. In regard to claims 7-9, as discussed supra, the various elements of the Wainer device can obviously be designed to have any suitable dimensions depending on the needs of the user. In regard to claims 10-12, although not specifically disclosed, the method as claimed can obviously be preformed during the usage of the Wainer device. In regard to claims 13 and 14, as discussed above, the claimed touchup jar and method of using the same are disclose and/or obvious in view of the Wainer reference.

Claims 1, 3, 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gelfand. In regard to claim 1, Gelfand discloses a device comprised of a cylindrical container 10 having a base, vertical sides and a treaded rim 12, a threaded

lid 13 that can be screwed onto the rim and a cylindrical absorbent element 23 attached to the inside of the lid. Although the Gelfand reference does not specifically disclose that element 23 is a sponge, the reference does disclose that any conventional absorbent material can be used (see column 2, lines 36-38). Accordingly, the Examiner takes official notice that it would have been obvious to one of ordinary skill in the art at the time the invention was made that a sponge can be used to form element 23 (since a sponge is considered to be a conventional absorbent material) without effecting the overall operation of the device. It is further noted that statements of intended use, i.e., "A paint touchup jar" do not lend any patentable structure to the claims. Further, the Gelfand device is capable of being used as a paint touchup jar should a user so choose to employ the device. In regard to claim 3, another lid 14 that is identical to the lid 13 is attached back-to-back to lid 13 (see column 2, lines 29-30). In regard to claims 7 and 9, although the Gelfand reference does not disclose the dimensions of the container or absorbent element the Examiner takes official notice that it would have been obvious to one of ordinary skill in the art at the time the invention was made that the container and absorbent element can be designed to have any suitable dimensions, including the claimed dimensions, without effecting the overall operation of the device.

Claims 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wainer in view of Gelfand. In regard to claims 15-19, as discussed supra, except for the back-to-back lids, the claimed device is disclosed and/or obvious in view of the Wainer reference. Although the Wainer reference does not disclose back-to-back lids, attention is directed to the Gelfand reference, which discloses another container

Art Unit: 3751

arrangement wherein two back to back lids 13, 14 are employed in order to prevent the contents of the container from spilling when the applicator is being used (see column 1, lines 48-49). Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ such back-to-back caps onto the Wainer device in order to prevent the contents of the container from spilling when the applicator is being used. In regard to claim 20, the method as claimed can obviously be performed by the device discussed above.

### ***Conclusion***


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Persi, Mains et al. and Tobey references are cited for disclosing other applicator jars.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Walczak whose telephone number is 571-272-4895. The examiner can normally be reached on Mon-Thurs, 6:30- 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on 571-272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David J. Walczak  
Primary Examiner  
Art Unit 3751

DJW  
10/28/05